

**REMARKS**

Claims 1, 3, 5, 7, 9 to 13, 15, 17, 19, 20, 22, and 25 to 34 remain in the Application.

The specification has been amended to comply with the Examiner's objections found on page 2, paragraphs 2 and 4 of his report. Full reconsideration is requested

The abstract of the disclosure has been amended to comply with the Examiner's objections found of page 2, paragraph 3 of his report. Full reconsideration is requested.

Claims 2, 4, 6, 8, 9/8, 10/9/8, 11/9/8, 12/9/8, 14, 16, 18, 19, 21, 22/21, 23, 24, 25/4, 25/21, 26/4, 27/4, 27/21, 28/4, 28/21, 29/4, 29/8, 30/4, 30/21, 31/4, 31/21, 32, 33, 35 now stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has reviewed the Examiner's rejection and has amended the claims where appropriate.

Claims 2, 4, 6, 8, 14, 16, 18, 21, 23, 35 each recite "the friction part" for which there is no antecedent basis. Applicant has deleted said claims rendering the rejection now moot.

Claim 19 is allegedly indefinite in its entirety for the claims of which it refers indigenously recites the framing sections, housing, and the roll screen in an assembled state thereby precluding the limitation of a kit of components. The Applicant had amended the claim to specify that the kit of components is "for assembly". It is submitted that this language precludes that the elements of the kit are in an assembled state. Reconsideration is respectfully requested.

Claim 23, line 3 recites "the framing members", "the corners", "the screen frame" for which there is no antecedent basis. As discussed above, the Applicant had deleted said claim rendering the rejection now moot.

Claim 32, line 1 recites "preferably a wind retainer" which is an indefinite recitation. Applicant has deleted said phrase.

Claim 33, lines 4 and 6 recite "the part" and "the hollow" for which there is no antecedent basis. Lines 7-8 are indefinite in their entirety. Applicant has reviewed Examiner's rejection and has amended claim 33 where appropriate.

Claim 35, line 5 recites "said braking elements" wherein there is no antecedent basis for a plurality of braking elements. As discussed previously, Applicant has deleted said claim rendering the Examiner's rejection moot.

Before commencing any rebuttal with reference to any alleged prior art the Examiner is respectfully directed towards the following excerpted case law from which Applicant will draw liberally. The following excerpts of U.S. case law represent Applicant's understanding of the test for novelty.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986) ("It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention, and that such a determination is one of fact.").

In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985) ("an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice, or device.").

In Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 209, 411 (Fed. Cir. 1984) ("exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference").

In Tights, Inc. v. Acme-McCrary Corp., 541, F.2d 1047, 191 U.S.P.Q. 305 (4th Cir. 1976); Saf-Gard Prods., Inc. v. Service Parts, Inc., 532 F.2d 1266, 190 U.S.P.Q. 455 (9th Cir. 1976); Shanklin Corp. v. Springfield Photo Mount Co., 521 F.2d 609, 187 U.S.P.Q. 129 (1st Cir. 1975) ("To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way.").

In re Beno (1985) 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985) a prior art patent or published application is a reference only for that which it teaches.

***In re Sun***, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished)

Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim.

...

But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed invention in the hand of one skilled in the art. . . . The examiner bears the burden of presenting at least a prima facie case of anticipation.

*Helifix Ltd. v. Blok-Lok, Ltd.*, 54 USPQ 2d 1299, 1304 (Fed. Cir. 2000)

"[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." *Donohoe*, 766 F.2d at 533, 226 USPQ at 621.

*In re Wilder*, 166 USPQ 545, 548 (C.C.P.A. 1970)

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. . . . However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within "the possession of the public."

*Ciba-Geigy Corp. v. Alza Corp.*, 37 USPQ 2d 1337, 1341 n.3 (Fed. Cir. 1995) (unpublished)

An anticipatory reference must be enabling, *see Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 U.S.P.Q.2D (BNA) 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 96 L. Ed. 2d 382, 107 S. Ct. 2490 (1987), so as to place one of ordinary skill in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990); *see Seymour v. Osborne*, 78 U.S. 516, 555, 20 L. Ed. 33 (1870) ("The knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention.").

Claim 34 now stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Dotson et al. The Applicant has traversed the Examiner's rejection by amending Claim 34 to include the locking detent as a feature of the corner connector presently claimed within Applicant's presently amended claim set. Specifically there is no discussion in Dotson et al. that one of the legs of the corner connector comprise:

"a locking detent for lockably connecting said connector to said adjacent framing section, said locking detent comprising a flexible portion in said leg, one end of said flexible portion having a gradually elevating profile that increases towards the other end of said flexible portion,"

These added elements are not new subject matter and are disclosed within paragraph 101 and Figure 21 of Applicant's disclosure. (This paragraph as well as others referred to in the response corresponding to the numbering of Applicant disclosure as originally filed and not

in the published Application.) It is submitted that the disclosure of Dotson et al. does not provide for a locking mechanism defined by Applicant's present claims. Reconsideration of said claim is respectfully requested.

Claims 1, 3, 5, 7, 9/7, 10/9/7, 11/9/7, 12/9/7, 13, 15, 17, 20, 22/20, 25-31 now stands rejected allegedly on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 9, 10, 11, 13 of U.S. Patent No. 6,701,994 in view of Dotson et al. The Applicant has traversed the Examiner's rejection by amended these claims as discussed previously to include the locking detent as a feature of these claims. As Dotson et al. does not provide for such a feature, it is respectfully submitted that the presence of the locking detent defined within Applicant's claims is novel. Reconsideration of the rejection is respectfully requested.

In an abundance of caution, though not a rejection of record, it is also submitted that Applicant's present claims rejected under 35 U.S.C. 102(b) are also not obvious in light of Dotson et al. or any of the other prior art cited by the Examiner. The traditional test enunciated in Graham vs. John Deere Company 383 U.S. 1, 148 U.S.P.Q. 459 1966, for Section 103 nonobviousness requires the fact finder to make several determinations. The test provides that the scope and content of the prior art be determined, the differences between the prior art and the claims at issue be ascertained, and the level of ordinary skill in the pertinent art be resolved. Thus, the patentability of the claims at hand must stem from the fact that the specific combination of the claimed elements was not disclosed in the prior art and the additional allegation that the specific combination of claimed elements was nonobvious to one of ordinary skill in the art.

Clearly, the prior art does not suggest or provide any reason or motivation to make such a modification to arrive at the Applicant's present claim set. With reference to In Re: Regal, 526 F. 2d 1399, 1403 n. 6, 188 USPQ 136, 139 n. 6 (CCPA 1975).

*"There must be some logical reason apparent from positive, concrete evidence of record which justifies a combination of primary and secondary references".*

In Re: Geiger, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987) (obviousness can not be established by combining pieces of prior art absent some "teachings, suggestion, or incentive supporting the combination"): In Re: Cho, 813 F. 2d 378, 382, 1 USPQ 2d 1662,

1664 (Fed. Cir. 1987)("discussing the Board's holding that the artisan would have been motivated to combine the references").

Therefore, it Applicant's view there is no evidence of motivation in the prior art, either within the references themselves, or knowledge generally available to one of ordinary skill in the art, to make the purported changes that may arrive at the claimed subject matter.

Likewise, it is not permissible to create a 20/20 hindsight reconstruction using Applicant's invention as a blue print to allegedly find elements of Applicant's combination in the prior art. This is not permissible as set out below.

*In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

*The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. (emphasis added) That knowledge can not come from the applicant's invention itself.*

*ATD Corporation v. Lydall, Inc.*, 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)

*Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.(emphasis added)*

*In Re: Fritch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992)

*"Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious(emphasis added). The court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."*

Claims 2, 4, 6, 8, 9/8, 10/9/8, 11/9/8, 12/9/8, 14, 16, 18, 21, 22/21, 25-31 now stands rejected allegedly on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 4, 9, 10, 11, 13 of U.S. Patent No. 6,701,994 in view of Mase. The Applicant has deleted said claims that incorporate the recitation of braking elements, thus making the Examiner's rejections moot.

Claim 32 now stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Burns as Burns discloses the claimed retainer 11,12. The Applicant has traversed the Examiner's rejection by amending claim 35 to specify that the flange parts are made of flexible material and that the retainer is releasable from the guide channel when subjected to a predetermined force. These amendments are not new subject matter and are disclosed within paragraphs 37 and 38 of Applicant's present disclosure. It is respectfully submitted that Burns has no discussion of such elements. Rather the retainer pieces 11, 12 of Burns appear to be made out of a non-flexible material. As a result, these pieces of Burns can not be removable from the guide channel when a predetermined force is applied to the retainer. In addition, the non-flexible retainer pieces of Burns can not be re-inserted into the guide channel without a significant dismantling of the apparatus. Reconsideration is therefore requested.

Claim 35 now stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Mase. Applicant has deleted said claim rendering the Examiner's rejection now moot.

If the Examiner has any questions, the Examiner is respectfully requested to contact Francis Ng at (905) 771-6414 at his convenience.

Respectfully submitted,



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FN/lvp